

REMARKS

In view of the following remarks, reconsideration and allowance are requested.

Claims 1-40, 43, 44 and 50-55 remain pending with claims 1, 14, 27, 40 and 54 being independent. Comments of applicant's representative are preceded by related comments of the examiner in small bold type.

Response to Arguments

2. Applicant's arguments filed February 10, 2006 have been fully considered but they are not persuasive.

Applicants argued that Sasaki teaches away from "storing the digital content at a first computing system; and sending the metadata and the publication information to a second computing system for storage separately from the first computing system." as recited in claim 1.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, as illustrated by the Office Action mailed October 17, 2005, "Sasaki et al. do not expressly disclose sending the metadata and the publication information to a second computing system for storage separately from the first computing system". Niwa, however, cures the deficiency of Sasaki et al. by disclosing this feature. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Sasaki et al. system/method to include the step wherein the metadata and the publication information are sent to a second computing system for storage separately from the first computing system. One of ordinary skill in the art would have been motivated to do this because it promotes quick data transmission by reducing the amount of information stored on a data storage device. Also, storing the metadata and publication information separately from the content helps to reduce unauthorized usage of content. That is, such storage arrangement prevents users from editing an expired file to extend their usage term.

Applicants argued that storing the digital content at a first computing system and the metadata and the publication information at a second computing system would change the principle of operation of the Sasaki system and render it unsatisfactory for its intended purpose. The examiner respectfully disagrees; notice, Sasaki et al. indicates in paragraph [0058] that "The systems and methods described" are "not limited to any particular hardware, firmware or software configuration, but rather they may be implemented in any computing or processing environment." This statement implies that it is possible to modify Sasaki et al. system to send the metadata and the publication information to a second computing system for storage separately from the first computing system because such modification would not alter the scope of their invention. Again, Sasaki et al. invention is "not limited to any particular hardware, firmware or software configuration".

As the examiner correctly notes, Sasaki does not disclose "sending the metadata and the publication information to a second computing system for storage separately from the first computing system." Contrary to the examiner's assertion, however, neither does Niwa disclose or make obvious this feature.

Niwa discloses techniques for presenting customized multimedia content by causing video segments having information content associated with a particular subscriber to be successively played as a continuous video program. (paragraph [0006]). The Niwa system includes a subscriber database that includes at least one subscriber characteristic for each subscriber. (paragraph [0010]). The Niwa system also include a description database that stores a content description table, which contains information describing the content of news video segments that are stored in a storage media separate from the description database. (paragraphs [0072] and [0073]). In operation, when a subscriber logs onto the Niwa system, this action triggers the Niwa system to use the content description table and the subscriber database to identify the video segments that are associated with this particular subscriber. (paragraphs [0149] – [0155]). The Niwa system orders the identified video segments into a playback sequence and presents the resulting video program of segments to the subscriber. (paragraphs [0165] – [0168] and [0176]).

The examiner appears to suggest that the information describing the content of the video segments of Niwa is associated with both “the metadata and the publication information” of claim 1. However, it is unclear where in Niwa the examiner finds disclosure of “publication information comprising distribution information that identifies one or more content distributors selected to distribute the digital content” as required in claim 1. Niwa does not disclose or suggest “content distributors selected to distribute the digital content.” Accordingly, there is no reason for the Niwa system to “[receive] publication information comprising distribution information that identifies one or more content distributors selected to distribute the digital content,” much less “[send] ... the publication information to a second computing system for storage separately from the first computing system,” as recited in claim 1.

Therefore, even if Sasaki were modified for the sake of argument according to the teachings of Niwa, the resulting combination still would not have all of the recited elements of claim 1.

Moreover, the applicant maintains that it would not have been obvious to one of ordinary skill in the art to modify Sasaki to include the feature of “sending the metadata and the

publication information to a second computing system for storage separately from the first computing system ...”

Sasaki describes the invention as

... a novel digital content distribution scheme that enables digital content owners to *reach new potential customers by leveraging the desire of users to share and exchange digital content, while protecting the commercial interests of digital content owners*. The invention enables users to fully enjoy digital content and, at the same time, the invention prevents unchecked distribution of unlicensed digital content. (paragraph [0005]).

Given the intended purpose of encouraging distribution of the digital content to potential customers while protecting the commercial interests of the digital content owners, it is no surprise that Sasaki does not disclose separating the metadata from the digital content at any point along the distribution path as such a modification would change the principle of operation of the Sasaki system and render it unsatisfactory for its intended purpose. If anything, Sasaki actually teaches away from “sending the metadata and the publication information to a second computing system for storage separately from the first computing system ...” by indicating that the digital content and the metadata are packaged into a single encrypted content package (also referred to as a “transfer file”) that is passed along the distribution path from a license manager to an end user via one or more content distributors. (paragraph [0041]; FIG. 4 shows a block diagram of a digital content transfer file).

The examiner contends that Sasaki implicitly teaches modifying its system to include the feature of “sending the metadata and the publication information to a second computing system for storage separately from the first computing system ...,” citing paragraph [0058] as evidence of this position. Paragraph [0058] states in its entirety:

The systems and methods described herein are not limited to any particular hardware, firmware or software configuration, but rather they may be implemented in any computing or processing environment. The encoding, decoding and content rendering processes described above may be implemented in a high-level procedural or object oriented programming language, or in assembly or machine language; in any case, the programming language may be a compiled or interpreted language.

“The test whether a particular [aspect] described in the prior art may be relied upon to show obviousness is whether the prior art provided an enabling disclosure with respect to [applicants'] disclosed [aspect]. Because the evidence showed that a certain [aspect] was a ‘hypothetical structure,’ it was not persuasive of obviousness.” *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986).

In this instance, there were no enabling details that are sufficient to teach or suggest the presently claimed invention; there is only a gratuitous mention of different structures that might be used. It is clear that paragraph [0058] referred to in the outstanding rejection is a mere wish list for future developments without any detail as to how such developments can be realized. This does not suffice to provide the requisite teaching or suggestion to make the present invention obvious.

Further, the general self-serving reference attempting to broaden the invention described in Sasaki cannot be read inconsistently with the other teachings in Sasaki. Throughout Sasaki, emphasis is placed on encouraging distribution of the digital content to potential customers, while protecting the commercial interests of digital content owners. To achieve these dual objectives, Sasaki requires that

End-users 26, 28 ***must*** register their portable media devices and playback software programs with license manager 22 in order to participate in the distribution system 10. During registration, a portable media device is associated with information relating to the owner of the device. ***The ownership information may be embedded in the portable media device*** and may be stored in a license database controlled by license manager 22. (paragraph [0040]).

The user does not have direct access to this ownership information, which is also referred to in Sasaki as a “user identifier.” (paragraph [0042]).

When a user purchases digital content, the commercial distributor retrieves the user identifier corresponding to the recipient user from the license database, generates metadata including the retrieved user identifier and license restriction codes, and packages the metadata with the digital content into a single content package prior to pushing the content package down

the distribution path to the recipient user. When a user's portable media device receives a content package, a playback software program compares the user identifier embedded in the media device itself with the user identifier included in the metadata of the content package. If there is a match, the user is considered a "licensed user" and playback of the digital content is permitted an unlimited number of times. If no match is made, the user is considered an "unlicensed user" and playback of the digital content is permitted a limited number of times as specified by license restriction codes included in the metadata of the content package. In order for this "match" or "no match" evaluation to be performed, all embodiments of the Sasaki system require metadata specifying a user identifier to be included with the digital content in the content package that is passed down the distribution path. This aspect of Sasaki is critical to its ability to combat unchecked distribution of digital content, while encouraging distribution of the digital content to potential customers. The examiner's assertion that "storing the metadata and publication information separately from the content helps to reduce unauthorized usage of content" is clearly contrary to the actual teachings of Sasaki.

For the reasons stated above, independent claim 1, and the claims dependent therefrom, are patentable over the prior art. The foregoing remarks also apply to independent claims 14, 27, 40, and 54, which have corresponding limitations, and the claims that depend from claims 14, 27, 40, and 54. The applicant respectfully urges that an indication of allowability for claims 1-40, 43, 44 and 50-55 be provided.

Claims 6, 9, 19, 22, 32 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al. and Niwa as applied to claims 1, 50, 14 and 53 above.

Claims 7, 13, 20, 33, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al. and Niwa as applied to claims 50, 1, 14, and 53 respectively above, and further in view of US Patent No. 6226618 to Downs et al.

Claims 8, 21 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al. and Niwa as applied to claims 50, 14 and 53 respectively above, and further in view of European Patent No. 104 1823 to Saito et al.

Claims 11, 12, 24, 25, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al. and Niwa as applied to claims 10, 1, 23, 24, 36 and 27 respectively above, and further in view of US Publication No. 2003/0023564 to Padhye et al.

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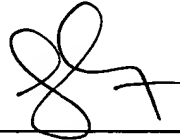
Attorney's Docket No.: 12587-015001 / 01313-00/US

The dependent claims are patentable for at least the same reasons given with respect to the independent claims from which they depend. It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: _____

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